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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/081,257	02/22/2002	Jeffrey W. Mankoff	24124721.000008	2774
23562 7590 05/26/2009 BAKER & MCKENZIE LLP PATENT DEPARTMENT 2001 ROSS AVENUE SUITE 2300 DALLAS, TX 75201				
EXAMINER CHAMPAGNE, DONALD				
ART UNIT 3688		PAPER NUMBER		
MAIL DATE 05/26/2009		DELIVERY MODE PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/081,257

**Applicant(s)**

MANKOFF, JEFFREY W.

**Examiner**

Donald L. Champagne

**Art Unit**

3688

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 58-90 is/are pending in the application.
- 4a) Of the above claim(s) 72-90 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 58-71 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 17 February 2009 has been entered.

### ***Supplemental Amendment***

2. Applicant filed a supplemental amendment (incorrectly labeled as a "preliminary amendment"; see MPEP 704.01(e) and 37 CFR 1.115) on 25 March 2009. The Office may enter a supplemental amendment only if it is "clearly limited to" one or more of six criteria (A)-(F) given in 37 CFR § 1.111(a)(2). The supplemental amendment does not comply with any of the six criteria. Hence, the supplemental amendment has not been entered. The following rejection is based on the claims filed 17 February 2009.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 53-71 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. "Partner" (e.g., claim 53, line 14) is indefinite. Partner with whom? The "first/second distribution partner/business advertiser that is unassociated with the network database" is indefinite. Said "association/unassociation" is not defined.

### ***Claim Rejections - 35 USC § 102 and 35 USC § 103***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 53-71 are rejected under 35 U.S.C. 102(e) as being anticipated by Meyer et al. (US006915271B1).

7. Meyer et al. teaches (independent claim 53) a method of managing virtual documents (*promotional incentives*)<sup>1</sup> on behalf of a plurality of consumers, wherein a given virtual document comprises data associating it with one of the consumers, the method comprising:

a) establishing a network database (*member database MMBR\_DB 111*, col. 18 lines 35-38 and col. 21 lines 18-20) on a network-connected computer (*member information computer 109*) said network database corresponding to a plurality of consumers, the network database having data records associated with consumers (*member incentive histories*, col. 21 lines 22-24) and including a set of categories (col. 21 lines 35-37);

b) receiving a first one of said virtual documents (*the clipped incentive*, col. 36 lines 48-52 and 58-67) at said network database from a document providing module (*DISPL*, col. 19 lines 27-31) in response to a consumer's first incentive offer selection (col. 19 lines 31-34), the first virtual document having a first attribute file identifying a classification for the first virtual document (*types of offers* and *categories*, col. 39 lines 56-61 and Fig. 31), and further having data identifying a first incentive offer that is provided by the first virtual document (*The name of the promotion*, col. 22 lines 43-44);

c) storing information regarding the first received virtual document within first data fields in a data record associated with the identified consumer (col. 36 lines 65-67), wherein the first data fields include the data identifying the first incentive offer (*The name of the promotion*, col. 22 lines 43-44) and the data identifying the first business advertiser (col. 23 lines 14-15);

d) and e): respectively repeating steps b) and c) for a second virtual document/*clipped incentive* (any *clipped incentive* other than the first);

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<sup>1</sup> Meyer et al. uses this phrase as well as *promotion* and *incentive* interchangeably, although Meyer et al. does also describe an *incentive* as a component of a *promotion*, col. 16 lines 17-18.

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f) categorizing the first and second virtual documents in the categories of the data record associated with the identified consumer according to the classifications provided in the attribute files of the first and second virtual documents (col. 39 lines 56-61 and Fig. 31).

8. The following language in claim 53 is non-functional descriptive material and was not given patentable weight (MPEP § 2106.01).

"data identifying a first distribution partner that is unassociated with the network database but distributed the first incentive offer, and data identifying a first business advertiser that is unassociated with the network database but is associated with the first received virtual document and the first incentive offer";

"the data identifying the first distribution partner"; and

"data identifying a second distribution partner that is unassociated with the network database but distributed the second incentive offer, and data identifying a second business advertiser that is unassociated with the network database but is associated with the second received virtual document and the second incentive offer".

This language is not functional because it does not alter how the process steps are to be performed to achieve the utility of the invention.

9. Meyer et al. also teaches at the citations given above claims 54, 55, 59 (where the clipping process reads on emailing), 60, 61, and 69-71.<sup>2</sup>
10. Meyer et al. also teaches claims 56-58 (col. 7 lines 39-46); claims 62-66 (col. 5 lines 19-26 and col. 17 line 60 to col. 18 line 6); and claims 67 and 68 (col. 43 lines 58-62 and col. 44 lines 9-15).

### ***Response to Arguments***

11. Applicant's arguments filed with an amendment on 17 February 2009 have been fully considered but they are not persuasive. The revised rejection considers the written arguments, as well as comments by the inventor and his learned attorneys in an interview on 14 May 2009. In particular, it was noted by the applicant team that the reference did not teach the limitation, "receiving a first one of said virtual documents at said network

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<sup>2</sup> With no patentable weight given to "associated/unassociated with the first/second business advertisers or the consumer by one of the distribution partners" in claim 54 and 58.

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database". The revised rejection makes this teaching clearer by interpreting the *clipped incentive* as the virtual document.

### **Conclusion**

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L. Champagne whose telephone number is 571-272-6717. The examiner can normally be reached after Noon on Monday and Wednesday through Friday. The examiner can also be contacted by e-mail at [donald.champagne@uspto.gov](mailto:donald.champagne@uspto.gov), and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.
13. The examiner's supervisor, James W. Myhre, can be reached on 571-272-6722. The fax phone number for all *formal* fax communications is 571-273-8300.
14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).
15. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, [www.uspto.gov](http://www.uspto.gov). At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

23 May 2009

/Donald L. Champagne/  
Primary Examiner, Art Unit 3688